

## REMARKS

### I. INTRODUCTION

In response to the Office Action dated December 2, 2003, claims 1, 22, 43, and 64 have been amended. Claims 1-105 remain in the application. Entry of these amendments, and re-consideration of the application, as amended, is requested.

### II. CLAIM AMENDMENTS

Applicants' attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of correcting grammatical errors giving rise to claim objections in the final Office Action. Such amendments were not required for patentability or to distinguish the claims over the prior art.

### III. NON ART REJECTION

Claims 1, 3-22, 24-43, and 45-63 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, claims 1, 3-22, 24-43, and 45-63 were rejected as follows:

Claims 1, 3-22, 24-43, 45-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1, 22, and 43 contain the limitation: "saving the filter and the specified selection criteria", which was not described in the specification. In the remark section of Applicant's Amendment dated October 21, 2003, page 17, Applicant relied on Fig. 17 and page 14, lines 11-22 of the specification to support this limitation. However, Fig. 17 shows an user interface for defining a filter but does not provide any mechanism to save "the filter and the specified selection criteria" as claimed. The text portion at page 14 lines 11-22 recites: "The changes would have to be saved, for example, with the "save" action 1411, and the contents of the object which had been select 1607, may change as appropriate". However, this "save" action is for saving the tree objects (i.e., object 1607 is "All JONES Tables", see Fig. 16), not the filter. Applicant Specification, page 14, lines 1-4 also teaches: "Additionally, to save a new customized tree or changes to an existing customized tree, a user would select "Save" 1411 or "Save as" 1413 from the pull down menu, as illustrated in FIG. 14. The tree would then be saved as a file either on a user's workstation or on a server". Thus, the subject matter "saving the filter and the specified selection criteria" was not described in the specification. Claims 1, 3-22, 24-43, 45-63 are therefore rejected.

Applicants respectfully disagree with and traverse the above rejections. The specification page 11, lines 12-23 provides:

Filter criteria is used to determine objects to be contained within one of the objects of the customized tree, for example, the root object. For example, filter criteria may be used to determine which tables are to be contained in the DSN1 folder object. Once a filter has been created, if the tables upon which the filter is applied change, the filter automatically modifies the customized tree to reflect the changed tables upon receiving, for example, a REFRESH command, which refreshes the screen. In one example of a selection criteria technique, if a folder is created with Jones tables according to this example, when additional Jones tables are added, the additional Jones tables are included in the folder. However, one skilled in the art would recognize that other selection criteria techniques may be used with the principles of the present invention. When a user is satisfied with the filter which has been created, the user may lock in the values by clicking "OK" 723.

Additionally, page 14, lines 11-22 provides:

FIG. 17 illustrates a Change Folder window 1701, generated by the customized tree creator 118, that is displayed in response to a "Change" action. The Change Folder window 1701 is the same as the Add Folder to Tree window 1201, except that the window reflects the selections previously made. In the present example the object type field is table 1703, and the Folder label for object field 1705 is "ALL JONES Tables". The filtering criteria 1707, 1709, 1711, 1713, 1715, and 1719 may be changed by the user if a different criteria is desired. The user makes changes desired and those changes take effect when the user clicks on the "OK" button 1721. The changes would have to be saved, for example, with the "Save" action 1311 and the contents of the object which had been selected 1607, may change as appropriate. The changed contents will then be reflected in the contents of the folder as displayed in the right subwindow when the object is selected, e.g. subwindow 1609.

FIG. 17 provides:

FIG. 17

As indicated in the above cited portions, the change folder window 1701 of FIG. 17 is the same as the add folder to tree window 1201 of FIG. 12 "EXCEPT that the window reflects the selections previously made". In this regard, the "selections previously made" are the filtering criteria as claimed and described on page 11. The paragraph on page 14 then continues and states that the user may change the filtering criteria 1707, 1709, 1711, 1713, 1715, and 1719 if a different criteria is desired. In this regard, if previously selected filtering criteria were not saved and stored, there would be nothing to change. Instead, the user would merely be creating new filtering criteria every time. The concept and use of storing such filter criteria is further provided by the paragraph on page 11 that provides for clicking "OK" to lock in the values.

The Office Action recites the description of FIG. 14 and the use of the save function. However, FIG. 17 indicates the retrieval of a previously saved filter and the ability to change the filtering criteria. Such filtering criteria are originally specified in an Add Folder window (see FIG. 7) which is saved when the user clicks "OK". Accordingly, the recitation of FIG. 14 and the language referring to the use of the "Save" command is irrelevant with respect to the filtering criteria.

Accordingly, Applicants submit that FIG. 7 illustrates the creation of a filter with filtering criteria that is stored. The storage of such filtering criteria is further enforced with the use of FIG. 17 that clearly provides for displaying previously stored/selected filtering criteria. Thus, the specification does provide support for the claims in the current form. In view of such support, Applicants respectfully request withdrawal of the rejection under 35 USC 112.

### III. PRIOR ART REJECTIONS

In paragraphs (1)-(2) of the Office Action, claims 1, 3-22, 24-43, and 45-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson, U.S. Patent No. 5,842,218 A (Robinson) in view of Glasser et al., U.S. Patent No. 5,956,715 A (Glasser), and Cotugno et al., U.S. Patent No. 6,198,480 B1 (Cotugno). However, in paragraph (3) of the Office Action, claims 64-77 were objected to as containing minor informalities but would be allowed if the informalities were corrected.

Applicants acknowledge the indication of allowable claims, but respectfully traverses these rejections.

Specifically, claim 1 was rejected as follows:

As per claim 1, Robinson teaches a method of creating a customized tree in a computer from an original tree comprising:

- "Creating a filter in response to user input, wherein the filter specifies a selection criteria to select objects to be contained within a selected object on the customized tree" at Col. 3 line 60 to Col. 4 line 8 and Figs. 8 and 18B.
- "selecting one or more objects on the original tree to be contained in the customized tree in response to user input by applying the filter, wherein the one or more objects are located in disparate places across different branches of the original tree" at Col. 3 lines 34-54 and Figs. 11-16;
- "linking the selected objects from the disparate places to each other in the customized tree in a user-specified manner" at Col. 3 lines 34-54 and Figs. 11-16.

Robinson does not teach the step of: "saving the filter and the specified selection criteria". However, Contugno teaches a similar method for defining a filter applied to a hierarchical tree structure including the step of: "saving the filter and the specified selection criteria" at Col. 47, lines 60-67. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Robinson and Contugno's teaching so that the filter can be reused later.

Robinson and Contugno do not teach the step of: "defining security restriction for accessing the selected objects using the customized tree". However, Glasser teaches a method of defining security restriction for a portion of a hierarchical tree structure (Col. 2, lines 13-33 and Fig. 4) includes the step of: "defining security restriction for accessing the selected objects using the customized tree" at Col. 8, lines 10-40 and Figs. 5, 6B. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Robinson and Contugno's method to include the step of "defining security restriction..." in order to allow user to change access permission to a portion of the tree structure; and, as indicated by Glasser, "provides a streamlined user interface that insulates the user from the complexities in making these change" and "perform access controls inheritance automatically. The user need not be concerned with distinctions between explicit and implicit access controls or the intricacies of the inheritance and propagation logic" (Col. 3 lines 15-10).

Applicants traverse the above rejections and reassert the rationale as stated in the prior Office Action response (which are incorporated by reference herein).

In addition to the previously stated arguments that Applicants reassert herein, Applicants submit that Contugno is not valid prior art with respect to the present invention. Specifically, Contugno was filed on January 29, 1999 and claims priority to a provisional application dated October 7, 1998. However, the present invention is based on a provisional application that provides a priority date of April 10, 1998. Clearly, the April 10, 1998 priority date of the present invention is prior to the October 7, 1998 date of Contugno. Accordingly, Contugno is not valid prior art with respect to the present invention.

In addition to the above, the Office Action addresses Applicants prior comments as follows:

Applicant's arguments filed October 21, 2003 have been fully considered but they are not persuasive. The Examiner respectfully traverses applicant's arguments.

Applicant argued that Robinson does not teach the limitation: "creating a filter in response to user input, wherein the filter specifies a selection criteria to select object to be contained within a selected object on the customized tree". On the contrary, Robinson teaches this limitation at Fig. 18B reproduced below...

In Fig. 18B, Robinson teaches the step of creating a filter in response to user input, wherein only the category selected by the user (i.e., "Boston, MA", "New York, NY", and "Washington, DC") are included in the customized tree (See Fig. 8 reproduced below)...

This step is similar to applicant step described in Fig. 17, in which columns of the tables are selected to be included in the customized tree based on their value.

Applicants respectfully disagree with and traverse such assertions. As claimed, an actual filter (for the selection criteria for the objects to be contained within a selected object on a customized tree) is created and saved. In the present claims, the term filter is not a verb or the process of filtering. Instead, a filter is created and saved. In this regard, the filter is an entity. Thereafter, as set forth in the claims, the filter may be applied. In Robinson, no such filter is created. Instead, various market categories are merely selected (see FIG. 18B) and a selected categorization table is produced (see Fig. 8). In this regard, Robinson fails to teach the creation of a filter and instead teaches a filtering process or a selection process. The textual support for such a conclusion lies in Robinson col. 10, lines 38-49:

FIG. 8 shows operation of the control interface 124c to select a certain subset of all the potential values for particular categorization levels in order to "filter" through the many records potentially available in order to narrow down to fewer records for the reorienting categorization table use for actually selecting records. The desired selection categorization hierarchy was established as shown in FIG. 7 and the control interface of 124c of FIG. 8 indicates that the market categorization level and the medium categorization level can be expanded to show subsets thereof. A corresponding screen shot of an actual implementation is shown in FIG. 11 for Example A and FIG. 17 for Example B.

Thus, contrary to that asserted in the Office Action, Robinson does not provide for the filter of the present invention and thereby fails to teach, disclose, or suggest various elements of the present claims.

In addition, the various elements of Applicants' claimed invention together provide operational advantages over the systems disclosed in Robinson, Glasser, and Cotugno. In addition, Applicants' invention solves problems not recognized by Robinson, Glasser, and Cotugno.

Thus, Applicants submit that independent claims 1, 22, 43, 64, 78, and 92 are allowable over Robinson, Glasser, and Cotugno. Further, dependent claims 3-21, 24-42, 45-63, 65-77, 79-91, and 93-105 are submitted to be allowable over Robinson, Glasser, and Cotugno in the same manner, because they are dependent on independent claims 1, 22, 43, 64, 78, and 92, respectively, and because they contain all the limitations of the independent claims. In addition, dependent claims 3-21, 24-42, 45-63, 65-77, 79-91, and 93-105 recite additional novel elements not shown by Robinson, Glasser, and Cotugno.

#### IV. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

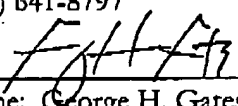
Terry Michael Bleizeffer et al.

By their attorneys,

GATES & COOPER LLP

Howard Hughes Center  
6701 Center Drive West, Suite 1050  
Los Angeles, California 90045  
(310) 641-8797

Date: January 30, 2004

By:   
Name: George H. Gates  
Reg. No.: 33,500

GHG/JSF/sjm